

Appl. No. 09/558,925

REMARKS

Claims 31-41, 50, 52-55, and 60-77 are pending in the present application. No claims are added or cancelled hereby. Claim 31, 50, 62, 70, and 76 have been amended herein. The present application was finally rejected on September 11, 2006. In response to that final rejection, Applicant submitted an appeal brief on March 5, 2007. No claims were amended by applicant's appeal brief. In response to the appeal brief, the examiner reopened prosecution (presumably withdrawing the final rejection), and issued several new grounds of non-final rejection, including rejections based on the judicially-created doctrine of obviousness-type double patenting, 35 U.S.C. 101 (non-statutory subject matter), and 35 U.S.C. 112 (indefiniteness). While such rejections should preferably have been made prior to or as a part of the final rejection of applicant's claims¹, applicant responds to those rejections herein. Furthermore, the examiner has located a new reference which is cited against applicant's claims in the Office Action. The rejections are addressed in the order in which they appear in the Office Action.

Initially, it will be noted that the Office Action states that claims 31-77 are pending and rejected in the present application. In fact, claims 31-41, 50, 52-55, and 60-77 are actually pending in the present application. Claims 42-49, 51, and 56-59 were cancelled in applicant's response, filed December 30, 2005, to an Office Action mailed on July 20, 2005. Accordingly, applicant will refer to claims 31-41, 50, 52-55, and 60-77 in the following remarks.

¹ "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." MPEP §706 (emphasis added).

Appl. No. 09/558,925

Judicially-Created Doctrine of Double Patenting

Claims 31-41, 50, 52-55, and 60-77 have been rejected in the Office Action under judicially-created doctrine of non-statutory double patenting. Initially, it must be noted that none of claims 21-49 of application 09/558,924 (the '924 application) have been allowed. Thus, as both the present case and the '924 application are pending, the double patenting rejection must be considered a provisional double patenting rejection (see MPEP 804.I.B, In re Mott, 539 F.2d 1291, 190 USPQ 536.). Most simply, then, applicant may defer any action in response thereto until such time as claims of either this application or the '924 application are indicated as allowable (other than pursuant to a double patenting rejection over the other).

However, it must also be appreciated that the language used in section 3 of the Office Action seems to confuse two grounds for rejection – the statutory and non-statutory types. While the first paragraph of that section makes general statements concerning nonstatutory obviousness-type double patenting, the more specific language of the last paragraph of section 3 states "Claims 21-49 of Patent Application 09/558,924 contains (sic) every element of claims 31-77 of the instant application..." This seems to imply that the Examiner views the two applications as claiming the same invention (i.e., same-invention-type double patenting is referred to as statutory double patenting). Applicant asserts that the claims of the present application are directed to a methods of presenting Internet content (such as obtaining and rendering), while the claims of the '924 application are directed to methods for tracking user interactions with certain types of content. Therefore, applicant asserts that there should be no same-invention-type double patenting, but requests clarification in the next communication from the Examiner.

Appl. No. 09/558,925

Finally, there appears to be no analysis or support for the assertion that claims 21-49 of the '924 application contain every element of claims 31-41, 50, 52-55, and 60-77 of the present application. For example, picking merely a few representative claims from the present application, where in the '924 claim set does one find the limitation "obtaining the complete definition of the frame for the visual manifestation" (claim 32), or any reference to the frame and content forming a calculator or media player (claims 39 and 40)? In general, the Office Action provides no analysis or support for the assertion of double patenting. As stated in MPEP 804(II)(B):

"Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent."

It is well-accepted that the burden is on the USPTO to set forth a *prima facie* case of unpatentability (Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990), see also MPEP 2106(B)). This burden has not been met by the sole and conclusory statement explaining the specifics of the present double patenting rejection: "Claims 21-49 of Patent Application no. 09/558,924 contains every element of claims 31-77 of the instant application..." A more complete analysis of the basis of the double patenting rejection is requested, providing applicant an opportunity to understand and respond to specific assertions, should the double patenting rejection be maintained in any subsequent Office Action.

Appl. No. 09/558,925

35 U.S.C. § 101

In the Office Action, claims 70-75 were rejected under 35 USC 101 as being "non-statutory." The Office Action asserts that claims 70-75 relate to non-functional descriptive material data (sic) on a storage medium, and fail to establish a statutory category for the claims. More specifically, the Office Action asserts that the claims merely recite a data object stored in memory. Applicant disagrees.

Prior to the amendment made herein to claim 70, that claim recited a medium having stored thereon a definition for rendering a frame. The functionality was the rendering of the frame. As such, the claim was directed to "functional descriptive material" (as defined by MPEP 2106) recorded on a computer-readable medium. As stated in MPEP 2106.01, second paragraph, "[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized."

However, to further accentuate this point, applicant has amended claim 70 herein. For example the computer readable storage medium of claim 70 (as amended) includes instructions for causing a general purpose computer to render a frame having a number of unique, specific characteristics. As such, Claim 70 (and claims 71-75 which depend therefrom) is (are) directed to a computer-readable storage medium having stored thereon a number of functional software objects. Thus, pursuant MPEP 2106.01, second paragraph, claims 70-75, as amended, satisfy the requirements of 35 U.S.C. 101.

Appl. No. 09/558,925

35 U.S.C. § 112

Claims 31-77 were rejected in the Office Action under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, it is asserted that applicants are attempting to claim the invention by excluding what they did not invent rather than what they did invent, and further that the scope of the claim is indefinite. Applicant traverses this rejection.

Limitations excluding elements from a claimed invention are often referred to as negative limitations. Such limitations are not *per se* impermissible, and citations to In re Schechter (as in the Office Action) for such a holding are no longer correct. In re Wakefield, 422 F. 2d 897, 904, 164 USPQ 636, 641. See also MPEP 2173.05(i). "So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph." *Id.*

In the present case, the language in question from claim 31 states that "...the Internet content is not confined by a window of a web browser program...." While in words this may appear to be a negative limitation, in actuality it is not. Rather, the precise steps of the claimed method are affirmatively recited. It happens that according to the steps of such a method, at least one element used by prior art processes (the rendering of content confined to the window of a Web browser program) is not required. A similar instance was presented in In re Bankowski, 318 F.2d 778, 138 USPQ 75 (CCPA 1963). The claims at issue in that case called for a number of steps for making an vaccine such that the medium used was "devoid of avian tissue." As the steps of the method were recited, the statement of the absence of an element typically used in those steps (i.e., a negative limitation) did not render the claims indefinite. It is

Appl. No. 09/558,925

therefore asserted that, similar to Bankowski, the claims of the present case do provide a definite scope of what they encompass, and therefore fulfill the requirements of the second paragraph of 35 USC 112.

35 U.S.C. § 103

Claims 31-41, 50, 52-55, and 60-77 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wolfe (USP 6,006,252 in view of Ko et al. (USP 6,292,185). As detailed below, applicant asserts that the claims as amended distinguish over the cited references, alone and in combination with one another.

Attention is directed to applicant's previous responses (e.g., that filed on June 13, 2006, and applicant's appeal brief filed on March 5, 2007) for a brief summary of the presently claimed invention. However, one facet of the present invention can be described in a sentence as the rendering of a frame and content without reliance a web browser. While at the time of applicant's invention, rendering internet content typically required the use of a web browser, applicant recognized that a web browser might not always be present on a user's device, and developed the claimed technique of rendering a frame and content independent of a web browser.

While applicant concedes that Wolfe mentions rendering content by an application or the like without requiring a web browser program to do so, applicant asserts that a web browser must be present and operating in order to acquire such content for display. The invention disclosed by Wolfe operates by employing a web browser to request a desired web page. Once

Appl. No. 09/558,925

retrieved, a system (which particular system depends on the embodiment) determines from the browser request or web page retrieved by the browser whether a supplemental document is available relating to the requested content. If so, an application other than a web browser can be used to display the supplemental document. Fundamental to Wolfe's technique, however, is a requirement that a user employ a web browser to make the initial request for a document. Col. 18, lines 33-36. (N.B., a browser is further required in this embodiment to communicate to the non-browser display application the identity of the documents retrieved. Col. 8, lines 36-38.) In this way, the Wolfe reference does not teach or suggest the limitation of obtaining content independent of the web browser, as claimed at line 3 of claims 31, 50, 62, and line 5 of claim 76, each as amended herein. Nor does Wolfe teach or suggest the similar limitation of "instructions operable to cause said content data to be obtained and said frame to be rendered on a general purpose computer independent of a Web browser program" (claim 70, lines 8-9).

Nor does Ko teach or suggest obtaining content independent of a web browser. The thrust of Ko is to obtain special code for customizing a web browser's appearance. Critically, "when viewing the web page (content), the web browser appearance is to be customized." (Ko, col. 3, lines 60-63). That is, the content is obtained and displayed using a web browser program, while the appearance of the window of that program is customizable. Thus, the content being displayed is not obtained without use of a Web browser program as claimed in amended claim 31.

It is without question that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, none of the references teach or suggest all of the limitations of the above-cited independent claims - obtaining Internet content without use of a

Appl. No. 09/558,925

Web browser being one such limitation not shown by the references. As such a limitation is neither taught nor suggested by the references when considered alone, it must logically also be missing from the combination of those references. Therefore, applicant asserts that since the cited references taken alone and in combination fail to disclose each limitation of claims 31, 50, 62, 70, and 76, that those claims are not *prima facie* obvious in light of the combination of Wolfe and Ko, and that those claim is patentable over that combination of references.

In addition, claims 32-41 each depend, directly or indirectly, on claim 31, claims 52-55, and 60-61 each depend, directly or indirectly, on claim 50, claims 63-69 each depend, directly or indirectly, on claim 62, claims 71-75 each depend, directly or indirectly, on claim 70, and claim 77 depends directly on claim 76. Therefore, each dependent claim contains all limitations of the respective independent claims on which they depend. As the combination of the cited references fails to teach all elements of independent claims 31, 50, 62, 70, and 76 and thus fail to render those claims *prima facie* obvious, for the same reasons the combination must also fail to teach all elements of dependent claims 32-41, 52-55, 60-61, 63-69, 71-75, and 77, and thus fail to render those claims *prima facie* obvious. Applicant therefore requests reconsideration and allowance of claims 31-41, 50, 52-55, and 60-77.

Conclusion

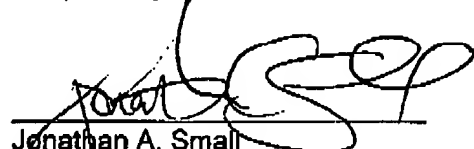
For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

Appl. No. 09/558,925

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and the scope of the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,


Jonathan A. Small
Attorney for Applicant
Registration No. 32,631
Telephone: 650-941-4470

343 Second St., Suite F
Los Altos, California
Date: August 6, 2007